REMARKS

Claims 14-35 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

If the Examiner relies on a new ground of rejection or a new reference in rejecting the Claims in the next Office Action, a Final Office Action would not be appropriate since there are no amendments that change the scope of the claims. Under present practice, second or subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is not necessitated by Applicants' amendment of the claims. **See MPEP § 706.07(a).**

REJECTION UNDER 35 U.S.C. § 103

Claims 14-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gallup et al. (U.S. Pat. No. 6,085,275) in view of Szczepanek et al. (U.S. Pub. No. 2003/0110344 A1) and Noguchi (U.S. Pub. No. 2002/0062466 A1). This rejection is respectfully traversed.

Gallup, either alone or in combination with Szczepanek and Noguchi, fails to show, teach, or suggest transferring storage controller control data from a first memory of a storage controller to a second memory of a test access port controller located on a disk controller.

Previously, the Examiner relied on Szczepanek to disclose this limitation. However, the Examiner now acknowledges that Szczepanek fails to disclose this limitation and instead relies on Gallup to disclose transferring control data from a first memory to a second memory. Applicants respectfully submit that Gallup still fails to make up for the deficiencies of Szczepanek.

Applicants respectfully submit that Gallup is directed to **communication between data processors**. (See Background of the Invention). Accordingly, Gallup discloses transferring processor data between processors. Applicants respectfully submit that transferring data between processors in not analogous to transferring storage controller control data from a first memory of a storage controller to a second memory of a test access port controller as recited in claim 14.

For example, the Examiner cites a claim listed in Column 135, Lines 4-37 of Gallup in support of this allegation:

> a plurality of data processors wherein each one of the plurality of data processors, comprising:
> a plurality of ports for communicating digital data;
> a first storage circuit for **storing a control value**;
> a second storage circuit;
> a plurality of switch circuits, each of the plurality of switch circuits being coupled between two of the plurality of ports, **each of the plurality of switch circuits being in one of a conducting mode and a non-conducting mode in response to a first portion of the control value**;
> a plurality of tap circuits, each of the plurality of tap circuits being coupled between a predetermined one of the plurality of ports and the second storage circuit, **each of the plurality of tap circuits being in one of the conducting mode and the non-conducting mode in response to a second portion of the control value**; and
> a first conductor for coupling one of the plurality of ports of a first one of the plurality of data processors to one of the plurality of ports of a second one of the plurality of data processors to selectively communicate digital data between the first one of the plurality of data processors and the second one of the plurality of data processors. (Emphasis added).

Initially, Applicants respectfully submit that this cited portion fails to even disclose transferring storage controller control data from a first memory to a second memory as the Examiner alleges. Instead, this cited portion only discloses a first storage circuit for storing a control value. Accordingly, this cited portion appears to be absent of any teaching or suggestion of transferring storage controller control data from a first memory to a second memory.

Further, Applicants respectfully submit that the control value is not analogous to storage controller control data. Instead, the control value determines whether the switch circuits and the tap circuits are in a conducting mode or a non-conducting mode. As noted above, Szczepanek discloses transferring JTAG instructions, not storage controller control data. Accordingly, the deficiency of Szczepanek that Gallup purportedly makes up for is **transferring storage controller control data**. Applicants respectfully submits that Gallup discloses a control value for data transfer between data processors and is absent of any teaching or suggestion of transferring storage controller control data. Accordingly, Gallup fails to make up for the deficiencies of Szczepanek.

In view of the foregoing, Applicants respectfully submit that claim 14, as well as its dependent claims, should be allowable for at least the above reasons. Claims 12, 22, and 29, as well as their corresponding dependent claims should be allowable for at least similar reasons.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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